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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,526	11/03/2000	Gerald Horn	HORN003	6897

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EXAMINER

FAY, ZOHREH A

ART UNIT PAPER NUMBER

1614

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,526

Applicant(s)

HORN, GERALD

Examiner

Zohreh Fay

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Claims 22-37 are presented for examination.

The remarks filed on November 15, 2004 have been received and entered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-37 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain imidazoline, an alkylating agent and compounds characterized by their ability to reduce eye redness, does not reasonably provide enablement for all imidazoline compounds, all alkylating agent and all compounds which are characterized by their ability to reduce eye redness which are capable of modulating pupil dilation and optimizing pupil diameter. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The factors to be considered in determining whether a disclosure meets the enablement requirements of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are:

1) The nature of the invention:

The claims are drawn to a method of modulating pupil dilation comprising an alpha-1 antagonist selected from the group consisting of an imidazoline and an alkylating agent in combination with an agent to reduce eye redness.

2) The state of the prior art:

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The prior art does not recognize that all alpha-adrenergic antagonists have the same clinical benefit. Applicant on page 4 of the specification admits that alpha-adrenergic antagonists represented by the indoles are of no clinical benefit for the present invention. Applicant also admits an alkylating agents offer potential for long term effectiveness for minimizing papillary dilation, but are less effective and cause more redness than imidazolines. The above admission demonstrate the unpredictability of alpha- adrenergic antagonists in terms of the present invention

3) The relative skill of those in the art:

The relative skill of those in the art is high.

4) The predictability and unpredictability of the art:

The unpredictability of the pharmaceutical and chemical art is high.

5) The breadth of the claims:

The claims are very broad and encompass the use of any imidazoline, any alkylating agent in combination with any compound capable of reducing the eye redness.

6) The amount of direction or guidance presented:

Applicant's specification provides guidance and it is only enabled for modulating pupil dilation using certain imidazoline or alkylating agent in combination with certain compounds capable of reducing eye redness. However, the specification provides no guidance, to enable one of ordinary skilled in the art to use the invention commensurate in scope with the claims. In re Dreshfield, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), gives this general rule: " It is well settled that in cases involving chemical

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and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired results". Applicant's specification does not set forth a representative number of examples of the combination of an imidazoline or an alkylating agent in combination with a compound capable of reducing the eye redness for modulating pupil dilation.

7) The presence or absence of working examples:

The examples in applicant's specification are drawn to the use of only two alpha-adrenergic antagonists for modulating pupil diameter.

8) The quantity of experimentation necessary:

Since compound structure and activity for each pharmaceutical use must be determined from case to case by painstaking experimental study, one of ordinary skill in the art would be burdened with undue experimentation to determine all imidazoline compounds, all alkylating agents and all compounds capable of reducing eye redness.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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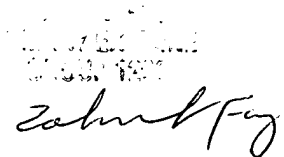
Claim 24 is indefinite in failing to set forth what is meant by the phrase "the compound". Does applicant intend to claim the compound, which has the ability to reduce eye redness, or the intended compound is something else.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Fay whose telephone number is (571) 272-0573. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Z.F


Zohreh Fay